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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,164	11/13/2001	Simon Muff	MAS-FIN-200	7203
24131	7590	12/14/2004	EXAMINER	
LERNER AND GREENBERG, PA P O BOX 2480 HOLLYWOOD, FL 33022-2480			MITCHELL, JAMES M	
			ART UNIT	PAPER NUMBER
			2813	

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/010,164

Applicant(s)

MUFF ET AL.

Examiner

James M. Mitchell

Art Unit

2813

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This office action is in response to the request for continued examination filed September 13, 2004.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Kozuka (US 5,691,570).

Kozuka (Fig 21; Col. 9, Lines 29-36) discloses a component placement method and integrated circuit chip comprising inherently providing an integrated chip containing a chip body (12) having an upper side and a under side, and at least two groups of metallic bonding pads (20, 16; 16, 20; via integral with metal 449) disposed on one of said upper side (Left portion) and underside (Right portion) of said chip body, wherein the first group (20,16) is inherently ordered in the standard pin/ wiring assignment or configuration (via "normal configuration"; Col. 1, Lines 9-13) and a second group (16, 20) of said at least two groups of said metallic bonding pads inherently ordered in the mirror-image pin assignment or wiring configuration (via "reverse configuration), the mirror-image wiring configuration being mirror-inverted in relationship the standard

wiring configuration (20,16; 16,20) and at least groups of metallic bonding pads (16) disposed on one of said upper side (Left portion) and said under side (Right portion) of said chip body, first group (122) of said at least two groups of said metallic bonding pads ordered in the standard assignment, a second group (124) said least two groups said metallic bonding pads ordered in the mirror-image pin assignment; and using the IC circuit for placing components on at least one side of a printed circuit board using surfaces mounting technique (Claim 6, line 63-64) enabling the chip to be connected the standard pin assignment (i.e. pads on boards shown in Fig 18 & 20 as admitted by applicant) wherein the bonding pads on the chip is twice the total number of pins in either the standard or mirror pin assignment.

With respect to the chip body being able "to be connected optionally to one of a standard wiring configuration for a standard pin assignment and to a mirror image wiring configuration for a mirror image pin assignment [etc]," the prior art is capable of performing the functions (Col. 1, Lines 9-13). The courts have held that the recitation that an element is "capable of" performing a function is not a positive recitation, but only requires the ability to so perform. In re Hutchinson, 69 USPQ 138 (CCPA 1946).

Furthermore with respect to claim 18, because the CLAIM 6 Kozuka calls for the chip to be mounted, it uses an integrated circuit for placing components on at least one side of the board.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kozuka (US 5,691,570) as applied to claim 1.

Kozuka (Fig 21) further discloses the standard wiring configuration and the mirror-image wiring configuration in each case extends on opposite sides of the chip body (via Left side and Right side); and the first group is disposed in a first row and said second group is disposed in a second row next to each other along two straight lines running parallel to each other; wherein the pads of the first and second row have a same spacing in relation to directly neighboring bonding pads (via 448, 449); with pins of the metallic pads of the first and second group are in a same direction; and the pads of the first and second group are lying in a common row lie along a straight line, and the

Kozuka does not appear to disclose the standard pin is realized by a positioning of said chip body first position, the mirror- image pin assignment realized by a positioning of said chip body in a second position and once in the second position can be transformed into the first position by rotation of said chip according chip body said upper side or said underside chip body or by translational movement said chip body along straight running parallel said upper side or to said underside said chip body wherein from a transformation from the second position into the first position, and vice versa, in each case, rotating said IC chip body by one of 90 , 180 and 270 degrees is required.

With respect to product by process claim of "the standard pin is realized by a positioning of said chip body first position, the mirror- image pin assignment realized by a positioning of said chip body in a second position and once in the second position can be transformed into the first position by rotation of said chip according chip body said upper side or said underside chip body or by translational movement said chip body along straight running parallel said upper side or to said underside said chip body wherein from a transformation from the second position into the first position, and vice versa, in each case, rotating said IC chip body by one of 90 , 180 and 270 degrees is required," or "pins... assigned in a same direction." The product is the same as that of the prior art. [E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

### ***Response to Arguments***

Applicant's arguments filed September 13, 2004 have been fully considered but they are not persuasive.

Applicant's gravamen is allegedly that the prior art does not disclose its number of pads on the chip body being twice the total number of pins. Examiner respectfully

disagrees. Applicant relies on the prior art to show that each pad of the prior art is matched with a corresponding pad (Applicant argument page 9). However, because applicant did not claim that the when either the standard or mirror image bonding pads are connected that the other bonding pads are excluded from being connected, the prior art even with all the pads connected is within the scope the broad limitation of the claim, because the pads along the chip are twice as many as either the **standard pin assignment** or **mirror image pin assignment** formed on the board.

Furthermore applicant argues that its invention avoids the use of two types of chips, by providing a chip body with a **single layout**, which includes two sets of bonding pads. Because, the limitations are not claimed or supported in its original disclosure "chip body has a single layout", applicant's arguments are moot. However to expedite prosecution it's argument is addressed. Applicant indicates that it achieves its result by having a chip body with two sets of pads. Because the prior art shows a chip body (12) with two sets of pads formed along a single layout/plane, it is within the broad scope of applicant's claim.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James M. Mitchell whose telephone number is (571) 272-1931. The examiner can normally be reached on M-F 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Whitehead Jr. can be reached on (571) 272-1702. The fax phone

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jmm  
November 26, 2004

  
CARL WHITEHEAD, JR.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800